

REMARKS

At the outset, Applicant wishes to express its sincere appreciation for the assistance of Examiner Pham in moving this application through the Office of Petitions and back into prosecution. Her attention to this case has certainly expedited its prosecution. In other preliminary matters, the Substitute Decision of the Office of Petitions dated April 19, 1999 notes that no power of attorney to the undersigned has ever been filed. Applicant filed a Power of Agent and Intervention of Assignee by Express Mail on April 22, 1999 along with an Information Disclosure Statement ("IDS"). Applicant respectfully requests recognition of the undersigned based upon the submitted documents. In the meanwhile, Applicant thanks the Office of Petitions for recognizing the undersigned's representation of apparent authority. Finally, Applicant respectfully requests that further action in this application be suspended until such time as the submitted IDS is matched with the case and the disclosures made therein can be fully considered by the Examiner.

The last substantive Office Action in this case was mailed on January 31, 1997 in parent application Serial No. 08/767,291. The remaining remarks are made in reference to that Action.

The drawings, specification and abstract are objected to for various reasons. Applicant respectfully requests that each said objection be held in abeyance, however, until such time as allowable subject matter may be indicated.

Claim 1 stands rejected under 35 USC §102(b) as being anticipated by U.S. patent No. 4,847,929 issued July 18, 1989 to Pupovic ("Pupovic"), U.S. patent No. 4,858,260 issued August 22, 1989 to Failor *et al.* ("Failor") or U.S. patent No. 4,862,529 issued September 5, 1989 to Peck ("Peck"). For the following reasons, Applicant respectfully traverses each said rejection.

Under 35 USC §102, every limitation of a claim must identically appear in a single prior art reference, as arranged in the claim, for that reference to anticipate the claim. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). Furthermore, the relied upon reference must show each and every element of the claim with sufficient clarity to place one of ordinary skill in the art in possession of the claimed invention. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). In order to properly compare the claim with an allegedly

anticipatory prior art reference, however, the claim must first be properly construed. *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994); *see also Young Dental Mfg. Co., Inc. v. Q3 Special Products, Inc.*, 112 F.3d 1137, 1141 (Fed. Cir.) (noting two step analysis for infringement [anticipation] analysis: (1) claim scope determined without regard for accused device [reference], then (2) properly construed claim compared with device [reference] to determine whether all claim limitations present), *reh'g denied, in banc suggestion declined* (1997); *cf.* DONALD S. CHISUM, CHISUM ON PATENTS §3.02[1] (1998) (noting direct applicability of classic infringement analysis to test for anticipation).

Patent claim construction begins with the words of the claims. *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619-20 (Fed. Cir. 1995); *Vehicular Technologies Corp v. Titan Wheel Intern., Inc.*, 41 F.3d 1084, 1088 (Fed. Cir. 1998). Unless it appears that the inventor intended otherwise, these words must be ascribed their ordinary meaning. *Bell Communications*, 55 F.3d at 620. But even then, the claims are not to be read in a vacuum; rather, claims must be construed in the light of the specification of which they are part and with a view toward ascertaining the invention. *Id.*; *see also United States v. Adams*, 383 U.S. 39, 49, 86 S.Ct. 708, 713 (1966); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978-80 (Fed. Cir. 1995) (*in banc*), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384 (1996). As an aid in this process, extrinsic evidence, such as that which may be provided by a dictionary or the like, may be utilized to facilitate understanding of the claim terminology. *Id.* at 980.

Before addressing the claim of the present application, however, it is necessary to revisit the Office Action of the parent application, which erroneously relies upon *Application of Hutchison*, 33 C.C.P.A. 879, 154 F.2d 135 (1946), for the proposition that "the recitation that an element is 'adapted to' perform a function is not a positive limitation in any patentable sense." Office Action, ¶7. Although the court in *Hutchison* addresses a particular recitation of the word "adapted" in a particular patent claim to reach the conclusion that the recitation "does not constitute a limitation in any patentable sense," *Hutchison*, 33 C.C.P.A. at 883, 154 F.2d at 138, this specific conclusion about a phrase recited in the introductory clause of a particular claim may not be generalized to other patent claims. *Bell Communications*, 55 F.3d at 621 (noting Federal Circuit has "long eschewed the use of an absolute rule

according or denying preambles limiting effect"). Furthermore, the Office Action completely ignores that *Hutchison* in fact addresses a preambular recitation whereas Applicant's usage of the phrase "adapted to" appears in an actual element of the claim. As such, *Hutchison* has no applicability to the facts of the present case. On the other hand, *Application of Dean*, 48 C.C.P.A. 1072, 291 F.2d 947 (1961), is on point.

In *Dean*, as now, the Office sought to deny a patent claim over an allegedly anticipatory reference on the ground that a claimed adaptation of an element should be given no patentable weight in light of *Kropa v. Robie*, 38 C.C.P.A. 858, 187 F.2d 150 (1951), dealing with the "limiting effect of preambles or the like." *Dean*, 48 C.C.P.A. at 1080, 291 F.2d at 952. The court admonished the Office that what controls "is no legal 'test' derived from some different fact situation but common sense interpretation of language according to the rules of grammar in the context in which it occurs." *Id.*, 291 F.2d at 952-53. Properly construed and with the admonition that words of a claim may not be arbitrarily disregarded on the basis of some nonexistent rule clearly in mind, Applicant's positive recitation of "a frame adapted to support patients having weights in the range of 500 to 800 pounds" is in fact limiting of the claim in a patentable sense. It requires the frame to be adjusted to the situation elucidated in the claim element as further understood through that situation's exemplification in the specification. See THE AMERICAN HERITAGE DICTIONARY 78 (2d ed. 1982) (defining "adapt"); see also *Markman*, 52 F.3d at 978-80.

Unfortunately, the previous error does not stand alone for the Office Action's reliance on *Ex parte Masham*, 2 U.S.P.Q.2d (BNA) 1647 (B.P.A.I. 1987), is likewise without merit and, therefore, improper as a basis for rejection. As was the case with *Hutchison*, the relied upon portion of *Masham* pertains to the particular effect of a particular preambular recitation in a particular patent claim. *Masham*, 2 U.S.P.Q.2d (BNA) at 1648. It has no applicability to the present application, wherein a different recitation in a different portion of a different patent claim is at issue. See *Dean*, 48 C.C.P.A. at 1080, 291 F.2d at 952-53; see also *Bell Communications*, 55 F.3d at 621 (espousing Federal Circuit's strong disfavor of absolute rules according or denying preambles limiting effect).

Finally, Applicant acknowledges the Office Action's restatement of the general rule regarding anticipation as set forth in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760 (Fed. Cir. 1983), *cert. denied*,

465 U.S. 1026 (1984), *overruled on other grounds by SRI Intern. v. Matsushita Elec. Corp. of America*, 775 F.2d 1107 (Fed. Cir. 1985) (in banc). Consistent with Applicant's previous assertions, the Office Action correctly paraphrases the rule that one who seeks a finding of anticipation "must show that each element of the claim in issue is found, either expressly described or under principles of inherency, in a single prior art reference...." *Id.* at 771 (Rich, J.) The Office Action fails, however, to fully heed Judge Rich's very next sentence reminding that "[p]reliminary to this determination, of course, is construction of the claims to determine their meaning...." *Id.* As clearly set forth *supra*, each element of the claim, properly construed, has not been considered in the Office Action; Applicant therefore respectfully submits that the conclusion of anticipation, in support of which *Kalman* is cited, is reached upon improper basis.

Turning at last to claim 1, it is noted that Applicant claims a bariatric bed comprising, *inter alia*, a frame adapted to support patients having weights in the range of 500 to 800 pounds. The specification of which this claim is a part goes to great length to describe in detail, through an exemplary preferred embodiment, the kinds of adaptations that contribute to a frame's ability to meet this positive limitation. Further, a common sense reading of the language of the claim can lead only to the conclusion that, however implemented, the frame must be capable of bearing the weight of very heavy patients without falling, sinking or slipping. See THE AMERICAN HERITAGE DICTIONARY 1222 (2d ed. 1982) (defining "support"). To conclude that a reference teaching a structure "that may not be able to support the patient for a long period of time before [it] may break" inherently meets the limitation of being capable of bearing the weight without breaking is to turn a deaf ear toward the common sense lesson of *Dean*. See 48 C.C.P.A. at 1080, 291 F.2d at 952-53.

Because Pupovic, Failor and Peck each fail to meet the positively recited limitation of a frame adapted to support patients having weights in the range of 500 to 800 pounds, none can anticipate claim 1. See *Minnesota Mining and Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1572 (Fed. Cir. 1992) (noting that absence from reference of any claimed limitation negates anticipation); see also *Bond*, 910 F.2d at 832 (noting every limitation must appear identically as arranged in claim in order for reference to anticipate); *Spada*, 911 F.2d at 708 (noting that each and every element must be shown with

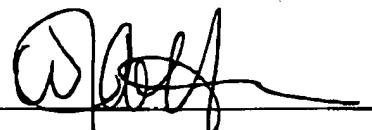
sufficiently to prove existence in prior art). The rejections thus shown to be improper, Applicant respectfully requests their withdrawal and allowance of claim 1 without further comment by Applicant on the elements thereof.

Finally, in an attempt to more expediently advance the prosecution of the above-captioned application to a conclusion, the foregoing amendments have now been made to more particularly point out and distinctly claim the subject matter regarded by Applicant as the invention. In particular, claim 1 has been amended to remove recitation intended for removal in an earlier action and claims 2 through 22 have been added to detail various features of the present invention thought to add unique functionality to a bariatric bed. No new matter has been added; entry is therefore respectfully requested. It is Applicant's belief that the invention as claimed patently defines over all prior art known to Applicant; Applicant therefore respectfully requests reconsideration and allowance of the claims, as amended, and passage to issue of this present application.

Respectfully submitted,

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